



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

CDTP006

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on NOVEMBER 13, 2005Signature C. Douglas ThomasTyped or printed name C. DOUGLASS THOMAS

Application Number

09/655,273

Filed

9/5/2000

First Named Inventor

THOMAS

Art Unit

2175

Examiner

RIMELL, S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 32,947☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

C. Douglas Thomas

Signature

C. DOUGLASS THOMAS

Typed or printed name

(650) 961-8300

Telephone number

NOVEMBER 13, 2005

Date

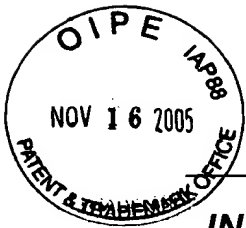
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: THOMAS

Attorney Docket No.: CDTP006

Application No.: 09/655,273

Examiner: RIMELL, S.

Filed: September 5, 2000

Group: 2175

Title: SYSTEM AND METHOD FOR PROVIDING AND
UPDATING ON-LINE FORMS AND
REGISTRATIONS

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service, with sufficient postage, as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 13, 2005.

Signed: C. Douglass Thomas

Printed Name: C. Douglass Thomas

PRE-APPEAL BRIEF

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Final Office Action, the Examiner rejected claims 6-12, 16, 17, 19, 20 and 22-33 under 35 USC 103(a). These rejections are fully traversed below.

Claims 6-12, 16, 17, 19, 20 and 22-33 are pending. Reconsideration of the Final Office Action is respectfully requested based on the following remarks.

In the Office Action, the Examiner rejected claims 6-11, 16, 17, 19, 20 and 22-24 and 27-31 under 35 USC 103(a) as being unpatentable over Freivald et al., U.S. Patent 5,898,836, in combination with Glogau, U.S. Patent 5,983,351; and rejected claims 12, 25, 26, 32 and 33 under 35 USC 103(a) as being unpatentable over Freivald et al. in combination with Glogau and "Library of Congress and Copyright Office Sign Agreement with UMI,"

Information Today, March 1999 (hereafter "*Information Today*"). These rejections are fully traversed below.

Freivald et al. describes an Internet document change-detection tool. Freivald et al. determines whether a web page document has changed. In doing so, a CRC is used as a checksum value. If the checksum value for a re-fetched web page document differs from a previously stored checksum for an earlier fetch of the web page document, then a user is notified that a change has occurred. The checksum determines whether the web page document is identical to the web page document previously fetched.

Glogau describes a web site copyright registration system and method. The system and method operate to examine a website or other work and produce copyright registration forms.

Claim 19 pertains to a method for determining whether a copyright registration update is needed. More particularly, claim 19 recites "comparing at least a portion of a website against a corresponding portion of an earlier stored version of the website that was previously subject to a copyright registration with the U.S. Copyright Office to produce a change indication" (claim 19, lines 3-6). Further, claim 19 recites "determining that the copyright registration update is needed for the website based on the change indication" (claim 19, lines 7-8).

Freivald et al. contains no teaching or suggestion for copyright registrations or for the need to update copyright registrations. Although Freivald et al. describes techniques for determining whether a web page document has changed, such techniques are not taught or suggested for use in determining whether a copyright registration update is needed.

Glogau does relate to copyright registrations in that the system and method therein described operate to produce copyright registration forms that can be printed and then physically mailed to the U.S. Copyright Office to seek a copyright registration. However, Glogau completely fails to provide any teaching or suggestion regarding updating copyright registrations.

Regarding claim 19, the Examiner asserts that: "It would have been obvious to modify Freivald et al. to add a copyright registration functionality to

the web management system of Freivald et al. in order to provide intellectual property protection to the reviewed web documents as taught by Glogau.” However, there is no teaching, suggestion, hint or motivation to combine these references as the Examiner proposes. The Internet document change-detection tool of Freivald et al. has nothing to do with copyright registrations. Glogau does relate to copyright registrations in that the system and method therein described operate to produce copyright registration forms that can be printed and then physically mailed to the U.S. Copyright Office to seek a copyright registration. In Glogau, a user determines when to seek assistance with obtaining copyright registration forms. Hence, there is no motivation for one of ordinary skill in the art to use the Internet document change-detection tool of Freivald et al. to determine whether a copyright registration update is needed. The combination of these references must then be the result of improper hindsight because the only suggestion or motivation to make this combination is from Applicant’s own application.

Both Freivald et al. and Glogau completely fail to provide any teaching or suggestion regarding updating copyright registrations. Even if Freivald et al. and Glogau were to be combined, these references completely fail to provide any teaching or suggestion regarding detection of a need to update prior copyright registrations. This serious deficiency prevents these references from rendering claim 19 unpatentable.

Based on the foregoing, it is submitted that claim 19 is patentably distinct from Freivald et al., alone or in combination with Glogau.

In rejecting claim 24, the Examiner relies on the rationale used to reject claim 19. The Examiner additionally states: “Note that the system of Freivald et al. can initiate more than just one single copyright registration. Any copyright registration initiated which is subsequent to some previously initiated registration is a subsequent registration.” Office Action, page 4. First, it should be noted that the rationale used to reject claim 19 was fully traversed above. Second, claim 24 is substantially different from claim 19. As such, it is respectfully submitted that the Examiner has failed to make out a *prima facie* rejection of claim 24. Third, claim 24 is patentably distinct from Freivald et al. and/or Glogau as detailed below.

Claim 24 pertains to performing a copyright registration update. Neither Freivald et al. nor Glogau teach or suggest an update to a copyright registration. The copyright registration for a prior version of a website is updated by a subsequent copyright for a subsequent version of the same website.

While Glogau may be able to be used to generate forms for various copyright registrations when used repeatedly, nothing suggests that any of the copyright registrations would be for the same work (e.g., website). Nor is there any teaching or suggestion in either reference for determining whether a copyright registration update is needed. Still further, there is no teaching or suggestion for “storing prior registration information pertaining to the prior copyright registration of the website” (claim 24, lines 6-7) or for “storing the subsequent registration information pertaining to the subsequent copyright registration of the website” (claim 24, lines 22-23). Moreover, there is no teaching or suggestion for “the update registration information automatically being based at least in part on the prior registration information pertaining to the prior copyright registration of the website” (claim 24, lines 16-18).

Based on the foregoing, it is submitted that claim 24 is patentably distinct from Freivald et al., alone or in combination with Glogau.

In addition, it is submitted that dependent claims 6-12, 16, 17, 20, 22, 23 and 25-31 are also patentably distinct for at least the same reasons as their corresponding independent claim 19 or 24. These dependent claims contain additional limitations that further distinguish over Freivald et al., Glogau and *Information Today*.

For example, claim 12 recites that the computer implemented method registers the copyright for the website with the U.S. Copyright Office via an on-line registration submission. The Examiner relies on *Information Today* to teach on-line copyright registration. However, there is no motivation for one of ordinary skill in the art to use the Internet document change-detection tool of Freivald et al., with the copyright registration form of Glogau and the on-line copyright registration of *Information Today* to determine whether a copyright registration update is needed. The combination of these references must

then be the result of improper hindsight because the only suggestion or motivation to make this combination is from Applicant's own application.

As another example, claim 20 recites: "providing a notification to a contact for the website when it is determined that the copyright registration update is needed for the website." None of Freivald et al., Glogau or *Information Today* teaches or suggests notifying a contact when a copyright registration is needed for the website.

As another example, claim 17 recites that "the on-line registration references the previous registration." Although Glogau can register individual website components, there is nothing taught, suggested or inherent in an on-line registration referencing a previous registration.

As still another example, claim 26 recites "automatically performing an on-line copyright registration submission with the U.S. Copyright Office for the website when the subsequent copyright registration is pre-authorized, the pre-authorization being provided prior to determination by said determining (d) that the copyright registration update is needed." Claims 32 and 33 recited similar limitation. As previously noted, there is no on-line registration capability in Glogau. Furthermore, Glogau fails to teach or suggest pre-authorization. It should also be noted that pre-authorization is further clarified to be prior to determination of the need for a copyright registration update. On page 5 of the Office Action, with reference to *Information Today*, the Examiner points to the deposit of a fee as being an act of pre-authorization. However, the pre-authorization of claim 26 services to authorize the performance of an on-line copyright registration submission. In contrast, a deposit of fees with the Copyright Office would merely be an account that can be utilized to pay Copyright Office fees. Hence, in no way is the deposit of fees a pre-authorization for an on-line copyright registration submission. Moreover, it appears that *Information Today* is referring to deposit of works being registered by copyright owners – not any sort of fees. Regardless, *Information Today* clearly fails to teach or suggest any sort of pre-authorization for an on-line copyright registration submission. Accordingly, it is submitted that none of Freivald et al., Glogau or *Information Today* teaches or suggests such pre-authorization as recited in claims 26, 32 and 33.